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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,800	11/04/2003	Bruno Grabenstaetter	Q78086	4018

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EXAMINER

NGUYEN, QUYNH H

ART UNIT PAPER NUMBER

2642

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/699,800

Applicant(s)

GRABENSTAETTER ET AL.

Examiner

Quynh H Nguyen

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/4/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

In page 2, line 21 "characterised" should be -- characterized --.

In page 4, line 3, "realise" should be -- realize --.

Appropriate correction is required.

### *Claim Objections*

2. Claim 1 recites the limitations "**said code, the entered code, and said dialed code**" in lines 5, 10, and 11, respectively. There are Lack clear antecedent basis for these limitations in the claim. Failure to make appropriate correction could lead to 35 USC § 112 rejection. For the purpose of examining, the limitations "**said code, the entered code, and said dialed code**" will be interpreted as -- said identification code --.

Claims 2-5 recite the limitation "the concerned dialed telecommunication" leave the claims vague. Suggested phrase is -- a concerned dialed telecommunication --. Failure to make appropriate correction could lead to 35 USC § 112 rejection. For the purpose of examining, the claims will be interpreted as suggested above.

Claim 1 recites the limitations "following the dialing" leaves the claim vagues. Suggested phrase is -- following dialing --. Failure to make appropriate correction could lead to 35 USC § 112 rejection. For the purpose of examining, the claims will be interpreted as suggested above.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As to claims 1 and 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

As to claim 7, the phrase "possibly" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6, and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlsen (U.S. Patent 5,509,062).

**As to claim 1**, Carlsen teaches method to perform a telecommunication between a caller terminal (Fig. 1 - *intelligent terminal 101-1*) and a callee terminal (*subscriber's*

*terminal does not show*) identified by and identification code (*dialed number*) (col. 6, lines 58-63), wherein it comprises the steps of:

collecting routing information (*stored destination number*) related to the identification code of the callee (*subscriber*), after enter said identification code at the caller's terminal (col. 6, lines 58-63) and before activating the telecommunication or establishing the telecommunication link (col. 2, lines 18-23 and col. 7, lines 13-22);

displaying at least a part of said collected routing information at the caller's end, for example directly on the caller terminal (col. 7, lines 22-23);

and finally either activating the telecommunication in order to establish the telecommunication link (*let the call complete*) corresponding to the identification code or canceling the current attempt to establish a telecommunication link based on said identification code (col. 7, lines 23-25).

**As to claim 6**, Carlsen teaches the information displayed at the caller's end comprises identification of the other end terminal which would be actually involved in establishing the telecommunication link if said dialed telecommunication is activated (col. 7, lines 22-23 - *stored destination number*), **or** the person to whom said other end terminal belongs.

**As to claim 8**, Carlsen teaches telecommunication terminal comprising a visual and/or audio display means and adapted to perform the method according claim 1 (Fig. 2, display 215).

**As to claim 9**, Carlsen teaches telecommunication system able to link together a plurality of telecommunication terminals having a visual and/or audio display means

Art Unit: 2642

(Fig. 1, 101-1 and 101-2), said system comprising one telecommunication network adapted for connection with one or several other telecommunication network(s) (Fig. 1, 126 and 128), and managed by a corresponding network controller (Fig. 1, 121), wherein said telecommunication terminals and said telecommunication system are further adapted to perform the method according claim 1.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsen (U.S. Patent 5,509,062) in view of Wu (U.S. Patent 6,442,266).

**As to claim 2**, Carlsen does not teach a concern dialed telecommunication is activated by a further action performed on said caller terminal.

Wu teach a concern dialed telecommunication is activated by a further action performed on said caller terminal (Fig. 5c, 77 and 80 and col. 1, lines 59-61 and col. 4, lines 39-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of activating the telecommunication by an action performed on said caller terminal, as taught by Wu, in Carlsen's system in order to provide callers to send enabling signal to establish the telecommunication link

Art Unit: 2642

whereby reducing waiting time by establishing the telecommunication link before the end of time delay period.

**As to claim 3**, Wu teaches a concern dialed telecommunication is activated by further pressing a determined key on the caller terminal (col. 2, lines 54-60).

**As to claim 4**, Carlsen does not teach a concern dialed telecommunication is automatically activated after a given timer following dialing.

Wu teaches a concern dialed telecommunication is automatically activated after a given timer following dialing (col. 4, lines 34-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made incorporate the feature of automatically activated after a given timer, as taught by Wu, in Carlsen's system in order to have a sufficient and user-friendly system by automatically activating or canceling the telecommunication link in the event that the caller forgets to keys in his or her choice.

**As to claim 5**, Carlsen does not teach a concerned dialed telecommunication is automatically cancelled in the absence of any further action performed on said caller terminal during a given timeout after dialing.

Wu teaches a concern dialed telecommunication is automatically cancelled (*inhibited*) if the calling party number matches a number on the list (col. 1, line 53 through col. 2, line 3). However, Wu also does not teach a concerned dialed telecommunication is automatically cancelled in the absence of any further action performed on said caller terminal during a given timeout after dialing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of automatically canceling the telecommunication link in the absence of any action performed by the caller terminal during a given timeout, in Carlsen's system in order to have a sufficient and user-friendly system by automatically activating or canceling the telecommunication link in the event that the caller forgets to keys in his or her choice.

### ***Allowable Subject Matter***

8. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

As to claim 7, the prior art of record fails to teach, or render obvious, alone or in combination, the information displayed at the caller's end comprises the identification of all the terminal(s) and/or other intermediate telecommunication device(s) which would be involved in the telecommunication link if said dialed telecommunication is activated, and their respective status and their mutual connections and relationships.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Art Unit: 2642

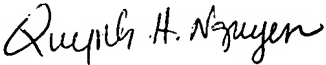
Rignell et al. (U.S. Patent 5,818,920) teach apparatus for controlling communication connections based on local time.

Sheinbein (U.S. Patent 4,277,649) teach method and apparatus for screening telephone calls.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:15 A.M. to 4:45 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Quynh H. Nguyen**  
**Patent Examiner**  
**Art Unit 2642**